REMARKS

Claims 30-36 are presently pending in the subject application. Claims 30-33 and 35-36 have been amended herein. In the Office Action dated February 9, 2004, claims 30, 34 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,067,461, to Dillon in view of U.S. Patent No. 6,654,787, to Aronson et al. ("Aronson"). Claim 31 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dillon in view of Aronson and further in view of U.S. Patent No. 6,275,848, to Arnold. Claim 33 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dillon in view of Aronson, in further view of Arnold with what is well known in the art. Claim 32 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dillon in view of Aronson further in view of Arnold, further in view of U.S. Patent No. 6,385,644, to Devine et al. ("Devine"). Claim 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dillon in view of Aronson in further view of U.S. Patent No. 6,317,485 to Homan et al. ("Homan").

Applicant disagrees with these grounds of rejection and wishes to clarify various distinctions of applicant's invention over the cited art. Reconsideration is therefore requested in light of the present amendment and following remarks.

Reference to the Interview in a copending Application

Reference is hereby made to the telephonic interview of May 24, 2004 between the undersigned attorney, Examiner England and Supervisor Jaroenchonwanit for copending application No. 09/943,894, which is divisional of the same parent as the present application. In that interview, the undersigned attorney explained the differences between the claimed invention and the cited art for the embodiments claimed in the copending and application. The undersigned also discussed the relevance of the issues in the copending application to the embodiments claimed in the present application. It was agreed that if an amendment were filed with an RCE application for the present application, similarly clarifying that the acts of receiving an indication of a plurality of recipients for an Email communication and the conditional storing of a single copy of the Email communication on a server based on whether the Email communication was designated for a plurality of users or not, were acts that were performed by Email communication program, then the presently claimed invention would be allowable over

the art of record. The present amendment to the claims conforms to the Examiner's indication in this regard.

Applicant's Teaching in Comparison to the Cited Art

The disclosed embodiments of the invention will now be discussed in comparison to the prior art. Of course, the discussion of the disclosed embodiments, and the discussion of the differences between the disclosed embodiments and the prior art subject matter, do not define the scope or interpretation of any of the claims. Instead, such discussed differences merely help the Examiner appreciate important claim distinctions discussed thereafter.

Applicant discloses a method and system for an Email communication program that securely distributes an electronic message (*i.e.*, electronic communication) that is designated for a plurality of different recipients in an efficient manner using centralized storage and management. In particular, the method implemented by the Email communication program involves storing a single copy of the message on a server, *specifically conditioned whether the message is designated for a plurality of recipients*. Unlike conventional methods, the present method *makes a decision whether the Email is designated for a plurality of recipients*, to determine whether to *store a single copy of the message on the server*. The system does not send the message to any recipient until it receives a response from at least one of the recipients that contains a request for the message. If the indication is not for multiple recipients the message is sent to the recipient without being stored.

In various embodiments, the Email communication program tracks, tests and routes requests from the recipients to access the message when appropriate and deletes the stored message when all recipients have responded and therefore all have received the message, unless at least one recipient requests that message be saved. The Email communication program also permits the user to perform certain local actions without perturbing the basic functionality of the system. For example, one recipient may send an instruction to the Email communication program to delete the Email communication. However, only one copy of the Email communication has been stored by the program, and under certain conditions, all recipients may not have seen the message. Rather than delete the stored copy of the Email communication, the system deletes the local notification of the Email communication that was sent to that particular user and stored locally on the recipient's system, leaving the single copy of the communication

stored on the server unperturbed. In other examples, the reipient user may individually store a copy of the Email communication locally on the recipient's system, regardless of the actions taken by the Email communication program with respect to deleting or storing the single copy of the Email communication.

Thus, a single copy of the message is on a server computer for delivery on an individual basis to multiple recipients when requested. In various embodiments, the Email communication program also receives instructions related to a particular recipient regarding the type of notification to be performed for that particular recipient, and sends the notification according to those instructions of that particular recipient In certain embodiments, the notification instructions are tailored by a particular recipient and in others, the notification instructions are automatically assigned for a particular recipient. In some cases the notification instructions indicate the message is to be encrypted, and the system performs the encryption accordingly. In certain embodiments, after all recipients have reviewed the message and no recipient has indicated a choice to save the message (or all have indicated a choice to delete the message) the system automatically deletes the single copy of the message. The instructions may include actions to be taken with respect to the message, such as to save or delete the message or to forward the message to another recipient.

The centralized storage and management of electronic messages to be distributed to a large number of recipients provides a variety of benefits. Because only a short indicator is sent to each recipient, the recipients' systems require only a small amount of storage space. In addition, each recipient system does not need the necessary software to save and manage the electronic messages. Instead, the recipient system need only be able to display a message and to send requests and other message action instructions to the server. In addition, central storage of the message provides easy access and control of the original message by an appropriate authorized user who may need access to the centrally-stored message for any number of reasons (*e.g.*, for backup, for authentication, or for modification). Removal or modification of the message to be distributed to a large number of users is therefore easily accomplished.

The cited prior art references, alone or in combination, fail to teach the combination of features of Applicant's embodiments in any manner that would fairly suggest or motivate one of ordinary skill in the art to create a message management system like Applicant's.

Dillon. Dillon is directed to sending notifications (alerts) of Email messages to recipients using a hybrid network that transmits notifications via a continuous high speed channel. Other than these features and in particular, the features regarding how the alerts are sent, the handling of messages as taught by Dillon is conventional in the art.

Applicant respectfully submits that the Examiner has mischaracterized the teaching of Dillon by reading more into that reference than is actually taught therein. In particular, the Examiner stated that "Dillon teaches a computer-implemented method for *one of a plurality of designated recipients* of an Email communication to receive the Email communication from *a server that stores a single copy of the Email communication*." In fact, Dillon is totally silent about any aspect of *storing a single copy* of the email communication that is *dependent* on whether the email communication is *designated for a plurality of recipients* or not. The cited text at col. 1, line 25, to col. 2, line 38, and col. 3, lines 12-65, teaches nothing about how to treat the Email communication that depends on whether a plurality of recipients is designated. Rather, the cited text at most teaches storing copies of the Email communication on a server without any condition, and sending a notification of the Email communication to a subscriber.

When taken for what it teaches as a whole, based on what one of ordinary skill in the art knows regarding how Email services conventionally operate, one would at most infer from Dillon that, if a plurality of recipients were designated, the Email communication would be stored in each of the subscriber's directories on the recipient's server, *i.e.,* multiple copies of the Email communication would be stored, one for each of the designated plurality of recipients. It is impermissible for the Examiner to read more into Dillon than is actually taught therein. Applicant teaches *storing a single copy of the Email based on whether a plurality of recipients is designated*, not Dillon.

In addition, the cited text at col. 1, lines 25 to col. 2, line 38, and col. 3, lines 12-68 does not teach that "the method of Dillon is performed by receiving computer lacking sufficient permanent storage to store the Email communication" as stated by the Examiner. The cited text refers generally to local area networks, the Internet, and paging notification systems and makes no reference to implementing the method particularly for receiving computers lacking sufficient memory for permanent storage.

Accordingly, Dillon fails to teach important elements taught by Applicant.

Aronson. Applicant also respectfully submits that the Examiner has mischaracterized the teaching of Aronson. The Examiner stated that "Aronson teaches storing a single copy of the Email communication designated for the plurality of recipient on a server (*e.g.*, col. 10, line 65 – col. 11, line 6)." In fact, the cited text teaches nothing about handling Email communications conditionally based on whether or not a plurality of users have been indicated. Aronson as a whole is directed to filtering Email based on content, not based on designated recipients. The cited text specifically teaches storing a single copy of the Email conditionally based on whether the content of the Email is designated as Spam, not whether a plurality of users are designated. Thus, unlike Applicant's system, if the Email is Spam sent to one user, the system of Aronson would store a single copy of the Email anyway, because it is Spam. Conversely, also unlike Applicant's system, if the Email is authentic and sent to a plurality of users, the system of Aronson would still send the Email to each of the designated users and not store a single copy on the server, because storage of a single copy on the server in Aronson is conditionally based on the content of the Email, not the number of designated recipients.

Accordingly, Aronson alone or in combination with Dillon also fails to teach conditional storage of a single copy of the email communication on the server based on whether a plurality of recipients are indicated.

Moreover, the motivation provided by the Examiner to combine Dillon and Aronson is "because it would be more convenient for a user to have a local copy of an Email in case the user is off line and wants to modify the local copy of the email, the user could without modifying the original Email that could be used as an archived document for reference if desired." While this is certainly one of the advantages of Applicant's embodiments, it is equally certain that neither Dillon nor Aronson teach the desirability of having such a method that provides such an advantage nor teaches a system to accomplish the same. The Examiner has not shown, and Applicant cannot find, where Dillon or Aronson would motivate one of ordinary skill in the art to provide such a method or system to store email messages in a single location conditionally based on whether a plurality of recipients were designated. Even if the cited art taught what the Examiner said it taught (which it does not), it would still be impermissible

hindsight for the Examiner to take the advantages provided from Applicant's teaching to supply the motivation to combine the elements taught in the prior art. The prior art references themselves must provide the requisite motivation.

Arnold. Applicant further submits that the Examiner has not properly characterized Arnold, which was said to teach "when access to the Email communication is no longer desired, indicating to the server to delete the Email communication, so that the server deletes the single stored copy of the Email communication after receiving indications from all recipients to delete the Email communication (*e.g.*, col. 4, line 25-col. 5, line 25)." What Arnold teaches at the cited passages and elsewhere, is detaching attachments from Email messages based on size (or type criteria), storing the attachment on the Internet, sending all the designated recipients the Email message devoid of the attachment, but with an embedded URL link, and allowing the recipients access to the stored attachment through the link embedded in the Email message. The cited text does not refer to deleting the email message *per se*, but rather to deleting the attachment that has been detached from the original Email message. Arnold thus has three components, the first (original) Email, a detached attachment from the Email separately stored, and a second Email that includes an address of the stored attachment. The deletion referred to in the cited text is with respect to the stored attachment, not the original Email.

Accordingly Arnold alone or in combination with Dillon and Aronson still fails to teach elements of Applicants embodiments.

Well known in the art. Applicant admits that it is well known in the art to locally store an Email communication. What was not known in the art, however, was to provide an Email communication that performs the other functions of Applicant's system as described above. Applicants system thus allows the recipient to still use the conventional local storage functionality, while at the same time, not perturbing the other aspects of the system, such as conditional storage of a single copy of the Email based on whether a plurality of recipients have been indicated, or, only deleting the local notification to the recipient, not the single stored Email communication itself, upon receipt of instructions to delete from less than all of the recipients.

Devine. Applicant would accept that the Inbox functionality described by Devine at col. 12, lines 40-55, may be construed as a repository for locally storing Emails. However, the Examiner has also cited this same text as teaching "deleting the stored Email communication

notification even if all recipients have not indicated to delete Email communication." Applicant disagrees with this characterization, because the Email communication of importance in Applicant's invention is the single copy of the Email communication stored on the server, which is stored as a single copy because a plurality of recipients have been indicated. Devine does not teach such a single copy storage of the Email communication. Accordingly, Devine fails to cure the deficiency of the primary references in this regard.

Homan. Applicant accepts that Homan teaches a preference system for determining how a subscriber will be notified of an Email communication. However, Homan also fails to cure the deficiency of the primary references with regard to conditional storage of the Email communication as a single copy on a server based on whether a plurality of recipients have been indicated.

The Claims and Rejections

Turning now to the claims and the rejections thereof, amended base claim 30 recites in pertinent part...providing an Email communication program on a server that is configured with instructions to store a single copy of the Email communication on the server if the Email communication is designated for the plurality of recipients... The amendment to the claim clarifies that the Email communication program makes this conditional determination of whether to store the single copy of the Email communication. Further to the interview mentioned at the outset of this response, the other amendments to this and the remaining claims also clarify what components are performing what acts in the claim.

As discussed above, the determination of whether or not to store a single copy of the Email message based on whether or not it is designated for a plurality of recipients, as emphasized in the italicized portions above, is not taught or suggested by any of the prior art. Moreover, the combination of references fails to provide any motivation for using such a method for handling Email communications. Therefore, Applicant requests withdrawal of the rejection of the base claim 30 on grounds of obviousness.

Each of the remaining claims 31-36 depend from an allowable base claim and are patentable at least for that reason. Applicant therefore also requests withdrawal of the rejection of these claims on grounds of obviousness. This is not an admission that patentability of any of

these dependent claims rises and falls with the independent claims. For example, as mentioned above, Arnold fails to teach the elements of some of the dependent claims as asserted by the Examiner. However, this expedient is used herein in the interest of brevity. Applicant reserves the right to further distinguish the dependent claims over the cited art at a later time if necessary.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a timely Notice of Allowance are earnestly solicited.

Respectfully submitted,

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Enclosures:
   Postcard
   Check
   Fee Transmittal Sheet (+ copy)
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